

**REMARKS**

Claims 13-23 are all the claims pending in the application. Claims 19-21 have been withdrawn. By this Amendment, Applicant amends claims 13 and 23 for improved clarity.

**I. Summary of the Office Action**

In this Office Action, the Examiner rejected new claim 23 under 35 U.S.C. § 112, first paragraph and under 35 U.S.C. § 112, second paragraph.<sup>1</sup> The Examiner maintained the prior art rejection. Specifically, claims 13-18, 22, and 23 presently stand rejected under 35 U.S.C. § 103(a).

**II. Claim Rejection under 35 U.S.C. § 112, first paragraph**

Claim 23 is rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner alleges that “uniform thickness” is not supported by the specification. Applicant respectfully disagrees.

There is no *in haec verba* requirement, MPEP § 2163. Fig. 4, pages 14 and 16-17 of the specification disclose an exemplary embodiment in which the “insulation coating 55 is formed on the slot bottom wall 53a and the pair of slot side walls 53b and 53c of each slot 53, thereby covering the slot bottom wall 53a entirely and covering the pair of slot side walls 53b and 53c. The insulation coating 55 has a specific thickness T, and continues from the slot bottom wall 53a to the pair of slot side walls 53b and 53c to cover them over.” (page 14, ¶ 29 of the specification). In other words, the insulation coating is of a specific thickness T, as shown in Fig. 4. That is, the coating is uniform in thickness because T is a specific number. In short,

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<sup>1</sup> Applicant notes that the Office Action indicates that claim 1 is rejected under 35 U.S.C. § 112, second paragraph, which is an error since claim 23 recites the allegedly indefinite features.

Applicant respectfully submits that the specification clearly provides support for the unique features in claim 23.

III. Claim Rejection under 35 U.S.C. § 112, second paragraph

Claim 23 is also rejected under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner alleges that “uniform thickness” is indefinite because Fig. 7 discloses different thickness in the groove area (*see* pages 2-3 of the Office Action). Applicant respectfully disagrees and traverses this rejection as set forth below.

Applicant respectfully notes that Fig. 7 is a third exemplary embodiment of the above-identified application and Fig. 4 which show a first exemplary embodiment that clearly depicts a uniform coating T. Further, Applicant respectfully notes that the grooves are formed after the uniform coating is created using spraying techniques. Accordingly, it is appropriate and necessary for the Examiner to withdraw this rejection of claim 23.

IV. Prior Art Rejection

Claims 13-18, 22, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP60-18648 to Denki (hereinafter “Denki”) in view of U.S. Patent No. 4,400,639 to Kobayashi et al. (hereinafter “Kobayashi”). Applicant respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

Of these rejected claims, only claim 13 is independent. Independent claim 13 *inter alia* recites: “spraying a powder of an electrical insulation material on the slot peripheral wall of each slot to form an insulation coating.” The Examiner alleges that a) forming a coating by spraying is not a critical step and is well known in the art and b) Kobayashi allegedly discloses spray

painting on col. 2, lines 30 to 32 (*see* page 6 of the Office Action). Applicant respectfully disagrees.

To begin, it is respectfully noted that an exemplary embodiment of the present invention only indicates that spraying method is well known such that details are omitted (page 15, ¶ 30 of the specification). No where does the specification indicate that it is known to spray a powder of an electrical insulation material on the slots... as set forth in claim 13. Furthermore, in an exemplary, non-limiting embodiment by spraying the electric insulation material, a uniform coating can be formed. In other words, it is not a matter of simple design choice.

In addition, the Examiner is reminded that most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d at 1316 (*citing In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some reason of the desirability of making the specific combination that was made by the applicant. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007). In other words, it is improper for the Examiner to simply disregard a particular operation because allegedly it is not critical or well known.

Furthermore, from the tenor of the grounds of rejection, it would appear that the Examiner has decided, even though no anticipatory or particularly relevant reference has been found, that the present invention is too simple to be deserving of a patent. As a result, the Examiner has formulated grounds of rejection which, at first blush, appear to be based on actual

prior art disclosure, but instead are based on a hindsight rationale that anyone could have come up with the idea of spraying the coating in combination with other features in claim 13.

Specifically, Kobayashi on col. 2, lines 28 to 33 recites: "If necessary, insulation is provided between the rotor winding and rotor core, which may be called a slot cell insulation. This slot cell insulation may be an insulation sheet or a coating of insulating paint on the inner peripheral surface of the slots." As is clearly visible, no where does Kobayashi disclose that the coat is formed using spraying.

There are several reasons why, on the present record, the Patent Office can, and indeed must, grant such a patent. First, as noted in MPEP § 2141, "Office policy has consistently been to follow Graham v. John Deere Co. in the consideration and determination of obviousness under 35 U.S.C. § 103." Grounds of rejection based on a rationale such as the one just described distort each of the Graham factual inquiries, and produce a distorted determination as a result. Since the rationale is not rooted in actual prior art, productive discussion regarding the true scope and content of the prior art is no longer feasible. This, in turn, renders it impossible to clearly ascertain the actual differences between the prior art and the claims at issue. Also, since the rationale is a purely hypothetical construct, it is by its very nature a creature of hindsight, which makes any advance over the art appear trivial.

Moreover, it is noted that the coat of insulation paint in Kobayashi is manufactured separately and inserted into the slot 9. That is, Kobayashi explicitly discloses an insulation sheet bent approximately in U-shape used as the slot cell insulator 6, which is fitted into the slot 9 with the end 18 being placed into the notch 12 (Figs. 3-6; col. 3, lines 33 to 35 and line 47 to col. 4, line 4). In other words, just like in Denki, Kobayashi discloses inserting the insulator 6 into the slot 9, which means that the insulation layer is manufactured separately and inserted into the slot

9 instead of spraying a coating of insulation on the side walls of the slots. In short, there is no disclosure in Kobayashi that the coating of insulating paint is sprayed as a powder on the walls. Denki and Kobayashi clearly do not disclose or even remotely suggest spraying a powder of an electrical insulation material on a slot peripheral wall. This argument remains un rebutted by the Examiner.

Furthermore, claim 13 recites: “cutting into the insulation coating on the pair of slot side walls at vicinity of the slot opening to form a pair of holding grooves opposing each other, each of the pair of holding grooves has a groove wall; inserting an electrical insulation member between the groove walls of the holding grooves for closing the slot opening, wherein the insulation coating is formed over continuously from the slot bottom wall to the pair of slot side walls and the groove walls of the holding grooves are formed in the insulation coating on the slot side walls.” The Examiner contends that Denki discloses the above-quoted unique features of claim 13 in Fig. 8, element 12. Specifically, the Examiner alleges that since Kobayashi discloses having a coating, it would be obvious to cut or grind on the finished coated insulation to form a groove (*see* page 6 of the Office Action). Applicant respectfully disagrees and notes that the Examiner’s position amounts to a mere speculation not substantiated by any evidence of record..

Fig. 8 of Denki does not show any cutting into the insulation coating on the pair of slot side walls. In fact, all that Denki discloses is that there may be a recessed part 12. There is no disclosure or even remote suggestion in Denki as to how and when the recessed part 12 is formed. In addition, Denki clearly does not disclose or suggest that the electrical insulation member is inserted between the groove walls of the holding grooves and that these groove walls are formed in the insulation coating on the side walls. Kobayashi does not cure this deficiency. The combination cannot possibly disclose the above-quoted features of claim 13.

For at least these exemplary reasons, claim 13 is patentable over Denki in view of Kobayashi. Claims 14-18, 22, and 23 are patentable by virtue of their dependency on claim 13.

In addition, dependent claim 23 recites "wherein the insulation coating formed by said spraying is uniform in thickness." The Examiner alleges that Denki discloses the above noted unique features of claim 23 (*see* page 5 of the Office Action). Applicant respectfully disagrees. Denki only discloses that the insulating member 8 has a rugged groove but fails to disclose or even remotely suggest the thickness of insulating member 8. Kobayashi does not cure this deficiency. For at least these additional reasons, claim 23 is patentable over Denki in view of Kobayashi.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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